

**REMARKS****I. Introduction****The Final Action:**

Determines claims 21-29 to be directed to a non-elected invention and withdraws them from consideration;

Finally rejects claims 8-14 under 35 U.S.C. § 112;

Finally rejects claims 8-14 are rejected under 35 U.S.C. § 101;

Finally rejects claims 8-11 and 13-14 are rejected under 35 U.S.C. § 102(b);

and

Finally rejects claims 8 and 12 are rejected under 35 U.S.C. § 103(a).

The Applicants respectfully submit that all rejections of record are traversed by the remarks below, and respectfully ask the Examiner to withdraw the rejections of record. Claims 1-29 remain pending in the present application

**II. The Finality is Improper**

The Applicant respectfully asserts that this Action has been improperly made final because the Examiner has proffered new grounds for rejecting an un-amended claim. In the Previous Action, the Examiner rejected claim 12 as obvious in light of *Graves* (the addition of claim 8 in that rejection section was an apparent typographical error). In the Previous Response, the Applicant demonstrated that the Previous Action did not meet the requirements for an obviousness rejection because no motivation was provided. In the Final Action, the Examiner again rejects claim 12 as obvious while contending that the doctrine of repetition of parts does not need to be supported by motivation and citing In re Coey and Peterson, 90 USPQ 216 (CCPA 1951). The Applicant, however, respectfully asserts that nothing in Peterson frees the Examiner from his M.P.E.P. § 2143 obligation to provide motivation for the alteration of a reference when making a obviousness rejection. Quite to the contrary, the Court in Peterson devotes nearly half of page 219 to describing in great detail why the repetition of a drying step would be obvious to one of ordinary skill in the art curing leather. It appears that Examiner is actually using Peterson as his supporting rational and M.P.E.P. § 2144 does allow an Examiner to provide a legal precedent as his supporting rational for the alteration of a reference. However, rational is still an essential element of a prima facie case,

and M.P.E.P. § 2144 does not free him from his obligation to at least provide the Applicant with the case. By forwarding Peterson as the supporting rational now, the Examiner has actually entered a new grounds of rejecting claim 12. Thus, under the dictates of M.P.E.P. § 706.07(a), making it final is improper. The Applicant respectfully asks the Examiner to withdraw that finality.

### III. The Withdrawal from consideration of Claims 21-29

On page 2 of the Final Action, the Examiner states:

Newly submitted claims 21-29 directed [sic] to inventions that are independent or distinct from the invention originally claimed for the reasons: the elected group II was drawn to a method, and the subject matter of claims 21-29 is drawn to a device/code.

However, the Applicant respectfully points out that “elected group II was drawn to a method, and the subject matter of claims 21-29 is drawn to a device/code” is not a permissible reason for determining whether or not sets of claims are drawn to independent or distinct inventions. When one claim set is drawn to a method and another claim set is drawn to a system M.E.P. § 806.05(e) requires:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

The Applicant respectfully point out that the Final Action does not show or even discuss either option, but rather merely restricts the additional claims as directed to a different category. However, even if the Examiner could make a *prima facie* showing in either option, the Applicant respectfully points out that claim 21 recites:

a means for communicating with at least one supplier of said material, wherein said communication includes conveying to said at least one supplier said quantity and a time frame and receiving from said at least one supplier a confirmation

With regard to such a claim, M.E.P. § 806.05(e) states that “If the apparatus claims include a claim to “means” for practicing the process, the claim is a linking claim and must

be examined with the elected invention.” Thus, claims 21-24 are drawn to a system for performing the method of claims 8-14 that contain a “means”. This renders each of these claims a linking claim that must be examined, making the Final action’s withdrawal of claims 21-24 improper. Claims 25-29 are drawn to a code operable to be run on said system and the Applicant respectfully assert that the Final Action also improperly withdrew claims 25-29, as well. The Applicants respectfully ask the Examiner to withdraw his constructive restriction of claims 21-29.

#### IV. The Rejection Under 35 U.S.C. § 112

In the Office Action dated February 13, 2004 (hereinafter “Previous action”), Claims 8-14 were rejected as being indefinite. Specifically, claim 8 was deemed indefinite for: 1) reciting “electronically;” 2) not indicating who (or what) determines the required quantity, and 3) not stating a specific origination point and destination point of the communication. In the Response dated May 13, 2004 (hereinafter “Previous Response”) the Applicant respectfully reminded the Examiner that breadth is not indefiniteness, see M.P.E.P. § 2173.04, and that while the specifics of the limitations may be left unrestricted, the scope of the subject matter embraced by claims 8-14 is quite clear.

In this Final Action, the Examiner again rejects claims 8-14 as indefinite, and contends that:

The claims nevertheless need to be drawn so narrowly as to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. *The examiner is the test* and in this case he has determined that there is *insufficient structure* recited sufficient to distinctly claim an invention. This is particularly proven true in Applicant’s failed attempt to distinguish claim 14 from prior art by arguments rather than by claim limitations which are not recited.

*See* Final Action page 6-7 (emphasis added). The Applicant respectfully points out, however, that the Examiner is mistaken in each step of his reasoning. First, he is not the test. M.P.E.P. § 2173.02 makes it very clear that the test is “one of ordinary skill in the art at the time of the invention was made.” Second, the Applicant respectfully points out that claims 8-14 are drawn to a method, thus *no structure* is actually required for acceptability under 35 U.S.C. § 112 second paragraph. Instead what is required is whether “the claim apprises one

of ordinary skill in the art of its scope.” Third, the Examiner apparently overlooked the Applicant’s traversal on page 10, where the Applicant specifically recites claim 14 limitations not taught by the cited art:

Claim 14 recites “using feedback that compares an actual run rate to a corresponding anticipated run rate and an actual production yield to an anticipated production yield,” which *Graves* does not teach. *Graves* does not, therefore, teach every limitation of claim 14 and the Applicant asks the Examiner to withdraw the rejection.

*See Previous Response page 10.*

When the correct test is applied, and the rejected claims are viewed as a whole, it becomes clear that claims 8-14 are in fact definite. Claims 8-14 cover electronic determinations made by a computer as well as those made by any other device or system within the scope of the claim. Claims 8-14 also cover quantity determinations made by a supplier, a user, or anything else within the scope of the claims. Claims 8-14 further cover communications that are, intentionally, not limited to any one specific origination or destination point. Thus, each of the items indicated by the Examiner are recitations that the Applicant has intentionally made broad. While the specifics of the limitations may be left unrestricted, the scope of the subject matter embraced by claims 8-14 is quite clear. Because this clarity is all that the M.P.E.P. requires, the Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 112 rejection of claims 8-14.

#### V. The Rejection of claims 8-14 Under U.S.C. § 101

In the Previous Action, claims 8-14 were rejected for failing to include a “recited utilization of any technical art.” In the Previous Response, the Applicant reminded the Examiner that the wording of 35 U.S.C. § 101 contains no “recited utilization of any technical art” requirement, but rather explicitly permits patents to “whosoever invents any new or useful process,” which claims 8-14 clearly satisfy.

In the Final Action, the Examiner cites the non-precedential decision of Ex parte Bowman, 61 USPQ 2d 1669 (Bd. Pat. App. & Int. 2001) as the source of the of a technical art recitation requirement. The Applicant respectfully submits, however, that the holdings of Bowman do not support the Examiner’s conclusions.

First, nothing in Bowman supports the Examiner's contention that a claim must recite the utilization of a technical art. In Bowman, an invention was found to be unpatentable because it comprised "nothing more than an abstract idea which is not tied to any technological art." *Id* at 1671. The Applicant agrees that "abstract ideas" are not patentable. However, this is a different requirement than the one the Examiner is attempting to apply. The Examiner has not rejected claims 8-14 as being an abstract idea, the Examiner has rejected claims 8-14 for failing to recite some specific verbiage. The Applicant respectfully asserts that the requirements echoed by Bowman are that claims promote the progress of science and the useful arts. Claims 8-14 clearly meet this requirement.

Second, Bowman is an unpublished and non binding precedent with facts markedly different from those of the present application. It appears that the Bowman Court's decision turned on the fact that the "examiner [found] that neither the specification nor the claims discuss the use of any technology with respect of claimed invention . . . [and] appellant [had] carefully avoided tying the disclosed and claimed invention to any technological art or environment." *Id* at 1671. This can not be said of the present invention. The specification is replete with descriptions of the component technology and concrete uses and for the claimed invention. These disclosures fully establish the technological art and environment. The concurring opinion of Bowman also seems to find fault in their being no claims other than method claims. *Id* at 1673 (differentiating the rejected claims from those of In re Warmerdam, 33 F.3d 1354 (Fed Cir. 1994)). In contrast, claims 1-7 and 21-29 of the present application claim, in detail, the apparatus and system used in the invention's implementation. The Applicant notes that the separation of the method claims from the apparatus and system claims is the result of the Examiner's restriction requirement, not an omission by the Applicant. It is, therefore, unfair for the Examiner to fault the Applicant for failing to tie claims 8-14 to technological arts, when it is the Examiner's own restriction requirement that establishes this ostensible failing.

The requirement the Examiner has attempted to apply can not be supported by the Bowman precedent. In addition, the non-precedential Bowman decision was the result of intentional omissions that are not present in the present application. Therefore, the Applicant respectfully asks the Examiner to withdraw his § 101 rejection to claims 8-14.

VI. The Rejection of claims 8-11, and 13 Under U.S.C. § 102(b)

In the Previous Action, the Examiner rejected claims 8-11, and 13 as anticipated by Graves, et al., United States Invention Registration No. H1743 (hereinafter *Graves*). In the Previous Response the Applicant demonstrated that *Graves* could not anticipate claims 8-11, and 13 because *Graves* did not teach “using feedback relating to performance of at least one supply chain participant.”

The Final Action again rejects claims 8-11, and 13 as anticipated by *Graves*. As demonstrated in the Previous Action, however, the cited column 17 lines 28-47 of *Graves* teaches “a feedback process used to re-calculate the needed amount of re-supply.” This feature of *Graves* merely monitors the level of a storage tank and compares it to projected levels. Such a comparison provides no information regarding the performance of a supply chain participant. The Examiner has also cited the definition of “performance” and contends that the level in the storage tank is a “performance.” Even if the level in the storage tank could be considered a “performance,” and the Applicant does not concede that it could, nothing about monitoring the level pertains to the performance of at least one supply chain participant. Therefore, the Applicant respectfully submits that claim 8 is patentable, and asks the Examiner to withdraw the rejection.

Claims 9-11 and 13 depend from claim 8, and each inherits that claims limitations. Therefore, each recite limitations not taught by *Graves*, and the Applicant respectfully asks the Examiner to withdraw the rejections of claims 9-11 and 13 as well.

VII. Rejections Under 35 U.S.C. § 103(a)

In the Previous Action, the Examiner rejected claim 12 as obvious in light of *Graves* (the addition of claim 8 in this rejection section was an apparent typographical error). In the Previous Response, the Applicant demonstrated that the Previous Action did not meet the requirements for an obviousness rejection because it did not address all of the limitations of claim 12 and failed to provide motivation.

In the Final Action, the Examiner again rejects claim 12 as obvious, claiming that “the reminder step [is] a repeat of the initial notification step.” See Final Action at 7. However, as stated in the Previous Response, the Applicant respectfully points out that “initial

notification step” is an order of materials. Thus a repetition of the initial order would be a reorder, not a reminder. Therefore, no actual repetition exists, and the Applicant respectfully asserts that neither the Previous nor the Final Action show that the modification of *Graves* teaches or suggest each and every limitation of claim 12. The Applicant respectfully asks the Examiner to withdraw the rejection.

In addition, the case cited as providing the Examiner’s rational deals with a situation fundamentally different than that of the § 103(a) rejection of record. The Applicant respectfully reminds the Examiner that M.P.E.P § 2144 only allows the Examiner to use legal precedent as supporting rational if the facts of the cited case are sufficiently similar. In rejecting claim 12, the Examiner claims that a final step repeats an initial step. As argued above, this contention is a mischaracterization of the limitations of claim 12. However, even if accepted as true, the analysis of Peterson would be inapplicable, as nothing in the Peterson decision discusses the final step repeating an initial one. The Peterson Court found that, at the end of a sequence, the repetition of the last step was likely obvious. The Examiner does not contend that the last step is repeated, but rather that the last step repeats the first. Therefore, the facts of Peterson are too dissimilar from those of the Examiner’s proposed modification, and Peterson can not be used as rational. Without rational, the Examiner can not make a *prima facie* case for rejecting claim 12, and the Applicant respectfully asks the Examiner to withdraw it.

### VIII. Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004991-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No, EV482738745US in an envelope addressed to: MS AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: October 20, 2004

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Respectfully submitted,

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Attachments